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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/819,965

03/28/2001

Takao Yoshimine

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10/10/2006

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EXAMINER

CHAMPAGNE, DONALD

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 10/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/819,965

Applicant(s)

YOSHIMINE ET AL.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-43,45-54,56-65,67-69 and 97 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37-43,45-54,56-65,67-69 and 97 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 27 June 2006 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 37-43, 45-54, 56-65, 67-69 and 97 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. "A refund quantity to be earned by the content creator" is new matter (at line 7 in claim 37, in similarly in the other independent claims). First, the word "refund" does not appear in the specification. Second, "refund" is presumably intended to be a synonym for the disclosed phrase "profit give back", but the specification (para. [0087] of the published application, US 20020046097A1) makes it clear that "profit give back" is being used to mean a sharing of profits. A sharing of profits is not a refund.
4. Applicant argues (pp. 3-4) by quoting specific material that support for "refund" is on pages 58 and 69 of the revised specification. The citations are not accurate. The examiner found the "p. 58" material on p. 61 of the clean copy and on p. 69 of the marked-up copy. The examiner was not able to find the "p. 69" material on that page or anywhere else in either the clean or mark-up copies.
5. Applicant appears to be arguing that the content creator pays an ordinary service fee to an Internet service provider and is compensated for creating content by refund of said ISP

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service fee. That argument is simply ridiculous. ISP fees are in the order of \$50 per month. It stretches credulity to suggest that applicant is going through all this trouble to gain someone \$50 per month.

6. This rejection can be overcome by replacing “a refund quantity” with either “a profit give back” (or equivalent phrases, such as “profits given back”), which is literally supported at para. [0087] of the published spec., or “a share of the profits” (an *equitable* or *fair* share would be acceptable since that appears to be applicant’s point, para. [0008] of the published application). The examiner deems the latter to be the idiomatic English translation of applicant’s “profit give back”. If applicant chooses the latter option, applicant must, in at least one place in the specification, associate the claimed phrase with “profit give back”. Para. [0087] is suggested as an appropriate spot since it is where applicant explains “profit give back”.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 37-43, 45-54, 56-65, 67-69 and 97 are rejected under 35 U.S.C. 103(a) as being obvious over Logan et al. (US005721827A) in view of Hammons et al. (US006477509B1).
9. Logan et al. teaches (independent claims 37, 48, 59 and 97) an apparatus, method and program for determining a refund, the method comprising: accessing and transmitting, via a network (col. 4 line 13 and Fig 1) selected content data (*programming*), which is inherently provided by a content creator (the content cannot create itself), to one or more user locations (*players 103*, col. 2 line 63 to col. 3 line 9), in response to a request from the one or more user locations for the selected content data/*programming* (col. 6 lines 45-51); calculating royalties to be paid to the content provider as a function of the number of transmissions of the selected content data/*programming*, and whether the selected content included advertising data (col. 20 lines 3-20); storing and accumulating the royalties to be

paid to the content provider in a content provider information database (*account number of the content provider*, col. 17 lines 15-19); and determining the *credits*, which reads on a plurality of levels of an entitled refund the refund quantity translates to, wherein said plurality of levels/*credits* of an entitled refund includes a fee credit (the reduction in *subscription cost*).

10. Logan et al. does not teach that the content creator earned a refund quantity, which is interpreted as a share of the profits (para. 6 above), and that the content provider provides the content creator with said refund quantity earned by the content creator. Because it is a very common business practice, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Logan et al. that the content creator earns a refund quantity, which is to say a share of the profits, and that the content provider provides the content creator with said refund quantity earned by the content creator.
11. It is common business practice to pay employees or other contributors for the simple reason that they will not otherwise work. Content creators commonly work only if they are paid, which is to say “earn a refund quantity”. Writers, artists and other content creators seldom distribute their works themselves. Said content creators typically have their work distributed by various agents, such as the content provider taught by Logan et al. Said content provider would typically compensate the content provider with whatever “refund quantity” the content creator had earned, in accordance with whatever contractual agreement existed between the contract creator and the contract provider.
12. Logan et al. does not teach calculating a refund quantity to be earned by the content creator as a function of a number of transmissions of the selected content data and whether the selected content included advertising data. Because the content provider is compensated in this way (para. 9 above), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Logan et al. that a refund quantity to be earned by the content creator be calculated as a function of a number of transmissions of the selected content data and whether the selected content included advertising data.
13. Logan et al. does not teach that said refund includes merchandise. Logan et al. does teach that said refund/credits comprises an incentive for accepting advertising (col. 7 lines 60-63). Hammons et al. teaches that said refund/incentive includes merchandise, especially

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merchandise sold by the advertisers (col. 2 lines 15-18). Because Hammons et al. teaches that this will increase income of the system operator (col. 1 lines 27-30 and col. 3 lines 24-26), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Hammons et al. to those of Logan et al.

14. Logan et al. also teaches at the citations given above claims 38, 49 and 60; claims 40-41, 51-52 and 62-63, where *subscription cost* (col. 10 line 1) reads on connection fee and use fee; and claims 45, 56 and 67 inherently.
15. Logan et al. also teaches at the citations given above claims 39, 50 and 61 (col. 9 lines 5-11); claims 42, 53 and 64 (col. 9 lines 62-63); and claims 47, 58 and 69, where *royalty payments due to content providers* (col. 15 lines 40-41) reads on contributions.
16. Hammons et al. teaches claims 43, 54 and 65 (col. 3 lines 18-23).
17. Neither reference teaches (claims 46, 57 and 68) that the ad is placed at the head (beginning) of the content. Because it is common practice to begin programming with advertising, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to the teachings of Logan et al. that the ad is placed at the head (beginning) of the content.

Conclusion

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 8:30 AM to 7 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
19. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for all *formal* fax communications is 571-273-8300.
20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information

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about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

21. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.


DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Donald L. Champagne
Primary Examiner
Art Unit 3622

29 September 2006